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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,573	09/17/2003	Robert Schlemmer	11836.0737.NPUS02 (MIDR73)	4592
26722	7590	08/02/2005	EXAMINER	
OSHA LIANG/MI ONE HOUSTON CENTER SUITE 2800 HOUSTON, TX 77010			SUCHFIELD, GEORGE A	
			ART UNIT	PAPER NUMBER
			3676	

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/664,573

Applicant(s)

SCHLEMMER, ROBERT

Examiner

George Suchfield

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of Refusal (PT O 892)
- 2) ☐ Notice of Refusal on Patent Drawing (PT O 948)
- 3) ☒ Information Disclosure Statement (s) (PT O 1449 or PPT O 1508)
- PT O (s)/Mailing Date 2/20/04.

- 4) ☐ Interview Summary (PT O 413)
- PT O (s)/Mailing Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PT O 152)
- 6) ☐ Other \_\_\_\_\_

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to a drilling fluid composition and method of preparing, classified in class 507, subclass 110.
  - II. Claims 8-10, drawn to a method of drilling a well and increasing shale formation stability, classified in class 175, subclass 64.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the composition or product provided by the Group I invention could be useful in a soil remediation or consolidation process. Also, composition appears to possess utility as a thickener in a coating or plastic formulation.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Jeff Bergman on July 27, 2005 a provisional election was made without traverse to prosecute the invention of Group II, claims 8-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims

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1-7 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. The disclosure is objected to because of the following informalities:

In the chemical formula(s) recited in page 7 of the specification, lines 1-16, it is not clear what the symbol "X" represents.

Appropriate correction is required.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by the document WO 99/31353.

In one of the WO'99 embodiments (note page 3, line 25 - page 4, line 27; page 8, lines 5-13), subterranean formation clay or shale minerals, which may be encountered during the drilling process, are stabilized by the injection or circulation of a fluid which comprises a mixture of reactants, one of which may comprise a carbonyl compound, such as an aldehyde or ketone, while the other reactant may comprise an amine compound, such as a diamine. The respective reactants effect a condensation polymerization reaction which forms a condensation polymer which effects clay and/or shale stabilization.

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Insofar as WO'99 treats a formation containing clay or shale minerals in the same manner as per applicant's claims 7-9, i.e., utilizing a similar composition with similar or corresponding reactants which inter-react in the same manner, it is deemed that such drilling/treatment process will inherently form an osmotic membrane and/or "semi-soluble or precipitated filming product", as recited.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Other references cited disclose process for drilling a well and/or effecting stabilization of shale or clay formations including the formation of an osmotic or semi-permeable membrane on the penetrated formation(s).

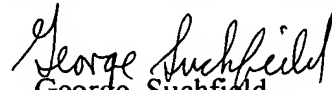
It is noted that Covency et al (6,787,507) also stabilizes a shale or clay containing formation through the formation of a condensation polymer in the borehole or formation utilizing respective amine and carbonyl compound reactants, and is thus deemed cumulative to the WO 99/31353 document, applied above against one or more of the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Suchfield whose telephone number is 571-272-7036. The examiner can normally be reached on M-F (6:30 - 3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
George Suchfield  
Primary Examiner  
Art Unit 3676

Gs  
7/29/05